

## REMARKS

The claim rejections of 1-3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,362,278 to *Pfaendner et al.* in view of U.S. Patent No. 6,224,804 to *Schwonke et al.* have been maintained in the present Official Action. The PTO states that *Pfaendner et al.* teaches polyolefins in a flooring and that *Schwonke et al.* teaches flooring with the specific density requirement of an elastomer between 0.85 to 0.892 g/cm<sup>3</sup>, which falls in the range of Applicants' claimed range of less than 0.910 g/cm<sup>3</sup>. In response to Applicants' previous arguments that both the suggestion and expectation for success for combining the two references must be found in the prior art, the PTO responds simply that "motivation exists" and the floor covering density requirements and materials are the same, thus no distinctions are seen.

Applicants respectfully note that the prior art relied upon, coupled with the knowledge generally available in the art at the time the invention was made must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine the references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Applicants respectfully contend that the PTO has failed to cite any motivation for combining the cited art in the present Official Action. Specifically, the PTO merely states that "motivation exists" for combining the art. Applicants respectfully assert that the Official Action is incomplete and request a complete Official Action setting forth the requisite motivation be provided.

As noted in Applicants' previous response, to support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the PTO must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The cited art does not expressly or impliedly

suggest the combination of the two nor has the PTO provided a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of the teaching of the references. As previously noted, the PTO has merely stated that "motivation exists." Such a statement does not follow a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious.

As noted by the PTO, the primary reference *Pfaendner et al.* does not teach or suggest that the claimed polyolefin has a density of less than that claimed in the present application. The PTO asserts that one of ordinary skill in the art would have been motivated to change the disclosed polyolefin in *Pfaendner et al.* with that disclosed in *Schwonke et al.* Applicants continue to contend that the PTO has failed to show any motivation outside that which is disclosed in Applicants' own disclosure which would have motivated one of ordinary skill in the art to combine that which is taught in the two cited references.

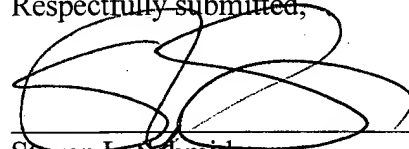
In response to Applicants' contentions that the prior art fails to teach or suggest a low emission floor covering having other advantages such as low emissions, no discoloration and prevention of unpleasant odor, the PTO notes that advantages which would flow naturally from the prior art cannot be the basis of patentability when the differences would otherwise be obvious. Applicants respectfully contend that the PTO has misunderstood Applicants' argument in response to the previous Official Action. Applicants note in the previous Official Action the PTO asserted that it would have been obvious to one of ordinary skill in the art to make an elastomer floor covering comprising copolymers of ethylene and octane of *Pfaendner et al.* with the densities of the present application since it is known that such elastomers help to provide a flooring with low emissions, no discoloration and prevention of unpleasant odors. In response, Applicants argued that such advantages are only found in the disclosure of the instant

application. The advantages of low emissions, no discoloration and prevention of unpleasant odor were cited by the PTO as motivating factors. Applicants' response noted that these factors are only recognized in Applicants' disclosure. Thus, there is no motivation for modifying the cited art to produce such a low emission floor covering, outside of that which is disclosed in Applicants' present application. Applicants note that the PTO must provide some motivation for combining the cited art outside of that which is disclosed in Applicants' own disclosure.

Thus, Applicants respectfully submit that claims 1-15 of the application are believed to be in condition for allowance and an early notice to such effect is earnestly solicited.

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Date

Respectfully submitted,

  
Steven L. Schmid  
Registration No. 39,358

WOMBLE CARLYLE SANDRIDGE & RICE  
P. O. Box 7037  
Atlanta, Georgia 30357-0037  
(404) 962-7539 (Telephone)  
(404) 870-8234 (Facsimile)

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Cheryl West